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EXAMINER

HOFFMANN, JOHN M

ART UNIT PAPER NUMBER

1731

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 08/929,836
Filing Date: September 15, 1997
Appellant(s): ARTERBURN, RUSSELL DONOVAN

Robert D. Touslee
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 25 May 2005 appealing from the Office
action mailed 26 April 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

- a) There is an outstanding appeal in 10/421,683 which is a continuation of the instant application.
- b) There was an earlier appeal (2000-0035) in the present application. A copy is attached.

(3) Status of Claims

The statement of the status of claims contained in the brief was correct.

However, in view of Appellant's arguments, the rejection of claims 16-20 is withdrawn.

The current status of the claims:

Claims 2, 4, 8-15 and 21-24 are rejected.

Claims 1, 3, 5-7 and 16-20 are allowed.

This appeal involves claims 2,4, 8-21 and 21-24.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct: The amendment after final rejection filed on 14 July 2004 has not been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The only remaining rejection is the rejection of claims 2-4, 8-15 and 21-24 under 35 USC 112 2nd.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claims 16-20 under 35 USC 112 – 1st paragraph. As well as the rejection of claims 16-20 under 35 USC 112 – 2nd paragraph.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

- a) Appeal 2000-0035 (a prior appeal in the present application)
- b) Brief on Appeal for Appeal 2000-0035
- c) Examiner's Answer for Appeal 2000-0035

d) US Patent 5,935,291 to Kim et al 10 August 1999 is mentioned in the Appeal Brief and responded to in this Examiner's Answer.

e) A marked-up enlargement of a portion of figure 7 of the above mentioned patent to Kim et al. The marking and enlarging was done by Examiner merely to more easily convey Examiner's position.

f) US Patent 3,810,741 to STALEGO (14 MAY 1974) is mentioned in the prior appeal and is mentioned in this Answer.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 4, 8-15, and 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the Decision on Appeal of 09 June 2003, claims were rejected under 35 USC 112 (2nd) as provided for under 37 CFR 1.196(b). As per page 14, lines 2-5 of the Decision, "...the meanings of various terms used in the claims are not readily apparent from the prior art or from the specification and drawings, for example...."

The terms "end portion", and "mid or central portion" are not readily apparent from the prior art or from the specification and drawings. First it is noted that Examiner

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could not find any definition for these terms in the present specification, nor in the prior art. Second, Examiner could find nothing in the specification which would guide a potential competitor in determining whether a particular a portion is (or is not) an "end portion" or a "mid or central portion".

See Allen Eng'g Corp. V. Bartell Indus. Inc. 299 F.3d 1336, 1348, 63 USPQ2d 1769, 1775 (Fed. Cir. 2002) (quoting Personalized Media Communications, LLC v. Int'l Trade Comm'n, 161 F.3d 696, 705, 48 USPQ2d 1880, 1888 (Fed. Cir. 1998)) ("In determining whether the claim is sufficiently definite, we must analyze whether "one skilled in the art would understand the bounds of the claim when read in light of the specification.") See also, Exxon Research & Eng'g Co. v. United States, 265 F.3d 1371, 1375, 60 USPQ2d 1272, 1276 (Fed. Cir. 2001) (citation omitted) (patent claims must be "sufficiently precise to permit a potential competitor to determine whether or not he is infringing").

Third, in the original Appeal, Examiner was of the opinion that any portion (including arbitrary portions) that is at an end is an "end portion". As argued by Appellant and agreed to by the Board, Examiner's position was inappropriate: "it is inappropriate for the examiner to "arbitrarily" define or redesignate various portions of the prior art apparatuses to achieve the claimed invention." (page 11 of Decision on Appeal, Appeal No. 2000-0035). Thus if an arbitrary portion cannot read on the claimed end portion, then it must be some specific or non-arbitrary portion which the claims are limited to. Examiner could find nothing which gives any guidance which would help a potential competitor to determine whether a somewhat similar screen portion is merely arbitrary portion which does not infringe, or an "end portion" that does not infringe.

Claim 23, line 5 has a period after "channel". It is unclear as to whether it should be a comma, and if not, how one should interpret the period. Thus the claim is indefinite as to what it means.

(10) Response to Argument

It is argued near the top of page 8 that the period in line 5 is an inadvertent oversight and suggests it should be converted to a comma. This is not convincing, the source of the error does not appear to be relevant as to whether or not the claim is definite. There is no indication as to why the claim is definite, nor any indication that the rejection is improper.

It is argued that the Board did not indicate that the claimed 'portions' were indefinite. The relevance of this is not completely understood – the record is quite clear that the Board gave no indication one way or the other as to whether the portions were definite or indefinite. Rather the Board held that the meaning of various terms was not clear and charged Examiner and Appellant with finding and correcting them all.

It is also argued that "the dictionary" (examiner does not know which) defines the term portion as "a part of the whole". This definition is not appropriate – because it does not serve to exclude arbitrary portions. As determined by the Board, the claimed portions excludes arbitrary portions. Thus any definition that can be relied on must at least exclude arbitrary portions.

It is further argued that from figures 6, 6A and 6B readily show the portions. Examiner agrees that figures 6, 6A and 6B (i.e. a specific embodiment) discloses portion the require portions. However the claims are not limited to that embodiment. Clearly the claims encompass other screens with "end portions" and "mid or central portions" that are somewhat different from those shown in figure 6..

Applicant points to US Patent 5,935,291 ('KIM') and indicates the usage of "central region" and since "central region" and "central portion" generally have the same meaning, both of the terms are definite. Terms are not viewed in a vacuum: prosecution history is a relevant consideration.

From *In re Bigio*, ___ F.3d ___ (Fed. Cir. August 24, 2004)

... *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). Absent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification or prosecution history when those sources expressly disclaim the broader definition. See, e.g., Liebel-Flarsheim Co. v. Medrad, Inc., 358 F.3d 898, 906-09 (Fed. Cir. 2004) (explaining requirement for an express disclaimer in either the specification or prosecution history)."

There is no evidence that KIM has any prosecution history which suggests that the "central region" does not include arbitrary central regions. The present application does have such a prosecution history: thus the comparison is not very relevant.

As shown in the attached marked-up enlargement of Kim's figure 7 (originally presented in Office action mailed 13 August 2003) . There are various sections (for convenience examiner has labeled them A, B, C, D, E and F) at the end of the screen; examiner considers them to be 'end sections'. Furthermore, there are various sets of these end sections: A+B+C, B alone, A+B+C+D+E+F, D+E+F, etc. Each set is a "portion", each portion is at the end, but there is nothing which would suggest whether any or all of them is or is not an "end portion". As indicated above, the Federal Circuit held that *patent claims must be "sufficiently precise to permit a potential competitor to determine whether or not he is infringing"*. If the present claims issued as a patent, such would not permit KIM et al to determine whether or not they are infringing.

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Appellant also refers to 35,000 US patents that use at least one of the terms in question to show the claims are definite. Again, there is no evidence which suggests that any of the 35,000 patents have a prosecution history which indicates that arbitrary portions cannot be "end portions".

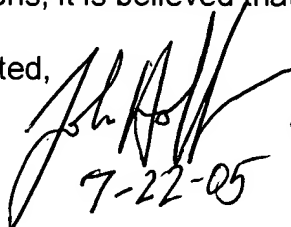
It is further argued that Examiner statement regarding the Board decision that "... Stalego does not have end portions" is erroneous. Examiner is unclear if this is an admission that those portions which Examiner interpreted to be "end portions" are in fact end portions. Regardless, Examiner simply disagrees with the Appellants argument because (as determined by the Board) the relevant portions of Stalego ends are not "end portions".

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



7-22-05

**JOHN HOFFMANN
PRIMARY EXAMINER
GROUP 1300**

Conferees:

Steven Griffin *SG*

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Patrick Ryan



APPENDIX:

Contents –

- a) Appeal 2000-0035 (a prior appeal in the present application)
- b) Brief on Appeal for Appeal 2000-0035
- c) Examiner's Answer for Appeal 2000-0035
- d) A marked-up enlargement of a portion of figure 7 of US Patent 5,935,291 to Kim. The marking and enlarging was done by Examiner merely to more easily convey Examiner's position.